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## RESPONSE TO OFFICE ACTION

**A. Status of the Claims**

Claims 1-17 were pending at the time of the Action and are presented herein for reconsideration. Claims 1 and 16-17 are amended herein. Support for these amendments can be found throughout the Specification, *e.g.*, Abstract, Examples 1-9.

**B. Rejections Under 35 U.S.C. § 112, First Paragraph**

The Action rejects claims 1-8 and 16-17 as lacking enablement for not specifying corn. In response, Applicants generally traverse, but note that in the interest of compact prosecution, claims 1 and 16-17 have been amended to indicate corn plants and/or corn seeds. The rejection is thus rendered moot.

The Action also alleges that guidance is not provided regarding auxins other than picloram. In response, Applicants respectfully traverse. Auxins are known in the art and described throughout the specification. For example, as mentioned in paragraphs [0027] and [0046], "Commonly used auxins include picloram (4-amino-3,5,6-trichloropicolinic acid), 2,4-D (2,4-dichlorophenoxyacetic acid), IAA (indole-3-acetic acid), NAA ( $\alpha$ -naphthaleneacetic acid), and dicamba (3,6-dichloroanistic acid)." Auxins are also mentioned, *e.g.*, in paragraphs [008] to [0010], [0045], [0071], and Examples 1-7. For the convenience of the Examiner, all paragraph numbers cited herein refer to paragraph numbering found in the published application.

The Action further asserts that guidance is not provided regarding cytokinins other than BAP. In response, Applicants respectfully traverse. Cytokinins are also known in the art and described in the specification. For example, as stated in the specification in paragraphs [0027] and [0046], "Commonly used cytokinins include kinetin, BA (6-benzylaminopurine), 2-ip (2-

isopentenyladenine), BAP (6-benzylaminopurine), thidiazuron (TDZ), zeatin riboside, and zeatin." These teachings and the knowledge in the art more than adequately demonstrate enablement of the claims.

Applicants note the burden on the Examiner regarding the Enablement requirement under MPEP§2164.01. As stated by the court, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." (emphasis added) 439 F.2d at 224, 169 USPQ at 370. In the current case, the element asserted to be lacking is both disclosed in the specification and known in the art.

Applicants further note the test for enablement, as explained in MPEP§2164.01. *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) "The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). Clearly, the substitution of picloram with other auxin, or the substitution of BAP with other cytokinin, could be performed without undue experimentation by one of skill in the art in possession of the specification. Applicants thus respectfully request that these rejections be withdrawn.

In the context of factors that may be adjusted to optimize *Agrobacterium* transformation in various species, the Action refers to Zhou *et al.* and Hansen *et al.* As mentioned by the Examiner, these articles indicate that various factors (e.g., *Agrobacterium* strain, vectors,

antibiotics, media, etc.) may be routinely altered in order to optimize *Agrobacterium* mediated transformation in plants. Applicants submit that these articles demonstrate that *Agrobacterium* mediated transformation has been used extensively in the past and may be used in conjunction or in combination with the instantly claimed invention.

In view of the foregoing, withdrawal of the rejections is respectfully requested.

**C. Rejection Under 35 U.S.C. §102**

The Action rejects the claims as lacking novelty in view of U.S. Patent 6,140,555 (Riechart). Applicants respectfully traverse.

U.S. Patent 6,140,555 (Riechart) is directed towards germinated mature seeds and germinated embryos. For example, the abstract of Reichert states in the first sentence, "Maize tissue may be regenerated from nodal extracts prepared from *germinated* mature seeds and *germinated* embryos" (emphasis added). Further, as stated in the Background section of Riechart, "Regeneration of maize involves the use of juvenile tissues by employing explants or tissues derived from seeds either pre- or post-germination." The last sentence of the Summary section in Riechart states, "The medium used to germinate mature seeds is [plant] growth regulator free." (Emphasis added). Applicants have searched Riechart and have been unable to identify a germination medium comprising both an effective amount of an auxin and an effective amount of a cytokinin. Thus, Riechart does not teach all of the instant claim limitations.

In contrast, the instant claims require that the mature seed or zygotic embryo is germinated in a media containing an effective amount of an auxin and a cytokinin. As stated in MPEP§2131, for a reference to anticipate a claim, it must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either

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expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987, emphasis added). Applicants thus submit that the rejection is improper and respectfully request that the rejection be withdrawn.

### CONCLUSION

In view of the foregoing, Applicants submit that the claims are allowable and respectfully request that the application be passed to issue.

The Examiner is invited to contact the undersigned attorney at (512) 536-3085 with any questions, comments or suggestions that may expedite the prosecution of the above-referenced patent application.

Respectfully submitted,



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